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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Tri/Mark Corporation	:	BEFORE THE
Trademark:	E-ACCESS	:	TRADEMARK TRIAL
Serial No:	76/159890	:	AND
Attorney:	Wendy Marsh	:	APPEAL BOARD
	McKee, Voorhees & Sease	:	
Address:	801 Grand Avenue	:	ON APPEAL
	Suite 3200		
	Des Moines, Iowa 50309-2721		

EXAMINING ATTORNEY'S APPEAL BRIEF

FACTS

Applicant filed the instant application Serial No. 76/159890 on November 6, 2000 to register the mark E-ACCESS (in small type) for "Door and enclosure hardware, including latches, locks and handles, for non-automotive vehicles, including agricultural and construction vehicles, recreational vehicles, utility and emergency vehicles, class 7 and 8 trucks, and for freestanding industrial enclosures." The original filing basis for this application was Section 1(b), intent to use. In an Office action dated April 11, 2001, the examining attorney refused registration under Trademark Act Section 2(e)(1) on the grounds that the applied-for mark is merely descriptive of the goods identified in the application. In addition, the examining attorney required that applicant submit a substitute drawing and amend the identification of goods. The examining attorney also noted a potential refusal under Section 2(d) as to a prior pending application, which was later withdrawn. Applicant's response of October 11, 2001 set forth arguments in favor of registration, amended the identification of goods and submitted a substitute typed drawing. The examining attorney made final the refusal to register under Section 2(e)(1) and the requirement to amend the identification of goods in an Office action dated December 13, 2001. On June 10, 2002, applicant filed a response amending the identification of goods and attempting to amend the application to the Supplemental Register. On June 27, 2002, the examining attorney issued a non-final action refusing registration on the Supplemental Register because the application was filed under Section 1(b), intent to use, and continuing the refusal under Section 2(e)(1) and the requirement to amend the identification of goods. Applicant filed an amendment to allege use on

December 6, 2002. In order to avoid abandoning applicant's application, the examining attorney considered the amendment to allege use a responsive paper and issued a December 30, 2002 office action continuing the previous refusals and requirements, including the refusal to register on the Supplemental Register, because applicant's specimens failed to function as a mark for the referenced goods. On January 30, 2003, applicant filed a response setting forth arguments in favor of registration. On March 12, 2003, the examining attorney reinstated the December 13, 2001 final refusal to register the mark on the Principal Register under Section 2(e)(1) and the December 13, 2001 final requirement to amend the identification of goods. In addition, the examining attorney made final the refusal to register on the Supplemental Register for failure to file an acceptable amendment to allege use with acceptable supporting specimens. On September 11, 2003 applicant filed a notice of appeal and on October 15, 2003 applicant filed its Appeal Brief. On November 13, 2003, the Office reassigned the application file to the undersigned examining attorney. Upon further review, the amendment to the Supplemental Register is acceptable because the minimum requirements for an amendment to allege use have been satisfied.¹ Therefore, the final refusal under Section 2(e)(1) is withdrawn. However, the final refusals as to the specimen of use and the identification of goods remain.

¹ Assuming all other minimum requirements are satisfied, an amendment to allege use does not itself fail because the specimen of use is not acceptable. The mark is not generic, therefore, the amendment to the Supplemental Register is acceptable.

ARGUMENT

I. The specimens applicant submitted in support of its amendment to allege use are not acceptable because they are mere advertisements for the goods, and, because of this improper use, the mark fails to function as a trademark for the referenced goods.

A mark does not function as a trademark for particular goods if that mark is not used properly in connection with the goods in trade, such that the proposed mark neither identifies the goods of the applicant nor indicates their source. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127. *In Re Remington Products Inc.*, 3 USPQ2d 1714 (TTAB 1987). TMEP §§1202 *et seq.* It is well established that invoices, announcements, order forms, bills of lading, leaflets, brochures, publicity releases and other printed advertising material generally are not acceptable specimens of use in trade for goods. *In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979); TMEP sections 903.05 and 903.07. *See In re Ultraflight Inc.*, 221 USPQ 903 (TTAB 1984). The issue of whether the specimens in the instant case are acceptable turns on whether the specimens are held to be packaging labels for the goods, or whether they are held to be advertising for the goods.

Applicant asserts that specimens showing use of a mark on the packaging or labels for particular goods are acceptable specimens of use for those goods. The examining attorney does not disagree with this general rule. However, in the instant case, the

packaging does not show the relevant mark as a source indicator for the relevant goods. The reference to the mark E-ACCESS is in an advertisement for goods other than those in the box. The label states that applicant has a "new line of electronic-enabled products" and then gives a list of the new products, including E-ACCESS. The advertisement then goes on to say that "system kits are available". An advertisement does not cease to be an advertisement merely because it is placed on a label.²

Applicant contends that the argument that the label in question does not function for applicant's goods "defies logic". Applicant's Brief at 4. Applicant misunderstands the examining attorney's refusal. A packaging label is only acceptable as a specimen if the label contains a mark which would be viewed by the public as a source indicator for the particular goods within the packaging. While the label in applicant's specimen may be acceptable for OTHER marks, such as, TRI MARK or EASK, it is not acceptable for E-ACCESS because that mark is not shown as a source indicator **for the goods contained within the packaging**. The term E-ACCESS is featured only as part of a secondary advertisement for applicant's other goods. In other words, the label contains a mark for the goods within the packaging, TRI MARK EASK, and also an advertisement for its other new line of products which consumers may wish to purchase, including E-ACCESS.

Applicant's argument that "[W]hile appellant advertises its 'E-ACCESS' goods as well as other goods on the box, the fact remains that the mark 'E-ACCESS' appears on a label

² The examining attorney notes that applicant itself states that the mark is used as advertising, "While Appellant advertises its "E-ACCESS" goods as well as other goods on the box..." Applicant's Brief at pg. 4.

that is applied to the product packaging. Put another way, while the product label at issue contains advertising, it does not cease to be a product label because of this..." appears to be an argument that all advertising wording on labels should be treated as a functioning trademark. Applicant's Brief at 4. Under this argument, the mark BMW Z4 on a label for windshield wiper blades stating "BMW WASHER PRO Check out our new line of BMW Z4s" would function as a trademark for the cars themselves. The examining attorney has not rejected applicant's specimen because it contains advertising, as applicant argues, but rather because the public would not perceive the mark E-ACCESS as a source indicator for the goods contained within the packaging.

II. Applicant's identification of goods is indefinite, overly broad, partially misclassified and beyond the scope of the original identification of goods.

The examining attorney required that applicant provide an acceptable amendment to the identification of goods. Applicant's last amendment to the identification of goods was indefinite, overly broad, partially misclassified and beyond the scope of the original identification of goods.

In its brief at page 6, applicant incorrectly lists its original identification of goods.

Applicant's original identification of goods was:

"Door and enclosure hardware, including latches, locks and handles, for non-automotive vehicles, including agricultural and construction vehicles, recreational vehicles, utility and emergency vehicles, class 7 and 8 trucks, and for freestanding industrial enclosures, in Class 12."

The identification applicant lists as "original" in its brief is actually the amended identification of goods from its October 11, 2001 response, except that in that response applicant classified the goods in class 9.

Applicant's final identification of goods is:

Latches and handles having electronic locks for vehicular applications, namely agricultural and construction equipment, motor homes, travel trailers, utility and service trucks, ambulance and fire trucks, bus and motor coaches, light/medium/heavy duty trucks, pick-up truck toppers/covers/toolboxes, off-road utility vehicles namely, all-terrain vehicles, lawn tractors, and golf cars and industrial cabinets and enclosure systems that house and protect electrical data communications, instruments and control equipment, in Class 9.

With respect to the scope issue, applicant's original identification listed "and for freestanding industrial enclosures" whereas the final identification of goods listed "and industrial cabinets and enclosure systems that house and protect electrical data communications, instruments and control equipment." The original identification was limited to hardware for freestanding industrial enclosures, rather than for all industrial enclosures. Applicant has omitted the term "freestanding", which creates an identification that is beyond the scope of the original identification. Applicant must limit its industrial cabinets and enclosure systems to those which are freestanding. In addition, applicant should be clear that its goods are latches and handles. As written, the identification could be read to state that applicant has industrial cabinets and enclosure systems rather than merely latches and handles for such goods [for example, applicant could state "and for freestanding..."].

The identification of goods is also indefinite, overly broad and partially misclassified. Latches and handles having electronic locks for class 12 vehicles and class 12 vehicle structural parts are in class 12 and latches and handles having electronic locks for class 9 vehicles (e.g. fire trucks) are in class 9, as shown below.³ With respect to the “latches and handles having electronic locks for....pick-up truck toppers/covers/toolboxes”, applicant must specify the type of toppers, e.g. caps, and whether the covers and toolboxes are fitted or not fitted. It appears that the latches and handles are for fitted pick-up truck covers and toolboxes, therefore, such goods would be in class 12. The latches and handles having electronic locks for freestanding industrial enclosures should be in class 9.⁴ Applicant should note that the office considers the term “or” to be indefinite. The “/” in the identification refers to “or”, and, therefore, the /’s are indefinite. Applicant may use “and” or commas as appropriate. Applicant may adopt the following identification, if accurate:

Latches and handles having electronic locks for vehicular applications, namely, for fire trucks; latches and handles having electronic locks for freestanding industrial cabinets and enclosure systems that house and protect electrical data communications, instruments and control equipment, in Class 9;

Latches and handles having electronic locks for vehicular applications, namely, for agricultural and construction vehicles, motor homes, travel trailers, utility and service trucks, ambulances, bus and motor coaches, light, medium and heavy duty trucks, pick-up truck caps, fitted pick-up truck covers, fitted pick-up truck toolboxes, off-

³ Note that on December 7, 2001, the examining attorney sent an e-mail to the Id/Class section of the Trademark Office with the following content: “...[I] have a question about whether something should be classified as a structural part of vehicles in class 12, or as the ‘thing itself’ i.e.: Re ‘Electronic latches, handles and locks for vehicles in the nature of agricultural, construction, recreational, buses, heavy duty trucks, utility and emergency vehicle’ it seems that the locks should be in 9—but what about the latches and handles? Should they be in 12 or 9 because they are electronic?” In response, Id/Class emailed “12”.

⁴ On December 3, 2003, the examining attorney sent an e-mail to the Id/Class section of the Trademark Office with the following content: “re ‘latches and handles having electronic locks for freestanding industrial cabinets and enclosure systems that house and protect electrical data communications, instruments and control equipment’, how could you classify these goods?” In response, Id/Class emailed “I think 9 due to the electronic lock.”

road utility vehicles in the nature of all-terrain vehicles, lawn tractors, and golf cars, in Class 12.

Although the goods span at least two classes, applicant has placed all of the goods in one class, and has paid for only one class. Applicant contends that the examining attorney did not indicate that applicant's June 10, 2002 amendment to the identification of goods was improper. This allegation is not correct. In each subsequent office action, the examining attorney informed applicant that the previous requirement to amend the identification of goods was continued. It should be noted that the June 10, 2002 amendment was in response to a final identification requirement. Applicant had an obligation to comply with the final identification requirement, and, in essence, the June 10, 2002 response was a request for reconsideration which the examining attorney denied as to the identification. Applicant's application was saved from abandonment only by the fact that applicant raised a new issue in that response. The identification of goods, in applicant's final version, remains indefinite, overly broad, partially misclassified and outside of the scope of the original identification.

CONCLUSION

For the foregoing reasons, the examining attorney respectfully maintains that the specimen of use and identification of goods remain unacceptable. The examining attorney requests that the final refusal to register the mark be affirmed.

Respectfully submitted,

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